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Total Number of Pages in This Submission

16

Application Number

09/867,174

Filing Date

05/29/2001

First Named Inventor

Robert H. Scheer

Art Unit

3625

Examiner Name

Yogesh C. Garg

Attorney Docket Number

31083.05US2

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

☒

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

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Extension of Time Request

☐

Express Abandonment Request

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Information Disclosure Statement

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Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
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After Allowance Communication to TC

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of Appeals and Interferences☒Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

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Status Letter

☒Other Enclosure(s) (please identify
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Remarks

- Appeal Brief in triplicate
- Check # 9001 in the amount of \$500.00
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Customer No. 34018 - Greenberg Traurig, LLP

Signature

Printed name

Gary R. Jarosik

Date

October 21, 2005

Reg. No.

35,906

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October 21, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Scheer)
Serial No. 09/867,174) Examiner: Yogesh C. Garg
Filed: May 29, 2001) Art Unit: 3625
Title: Method For Selecting A) Attny Docket: 31083.05US2
Fulfillment Plan For Moving)
An Item With An Integrated)
Supply Chain)

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 11-20 which rejection was set forth in the final Office Action mailed August 12, 2005. A timely Notice of Appeal was filed.

This brief is accompanied by the fee required by 37 CFR § 41.20

This Appeal Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

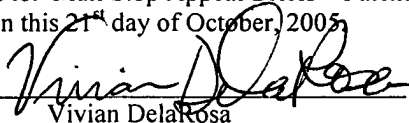
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By:


Vivian DeLaRosa

I. Real Party In Interest

The real party in interest is W.W. Grainger, Inc.

II. Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application, claims 11-20 remain pending and, having been finally rejected, are the subject of this appeal.

Claims 1-10 were canceled during the course of prosecution.

The Section IX appendix provides a clean, double spaced copy of pending claims 11-20.

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

With reference to Fig. 7 and Page 42, line 17+, the claimed subject matter is generally directed to a computer readable media having instructions for use in selecting a fulfillment plan for moving an item within a supply chain that is distributed over a plurality of geographic locations. To this end, the instructions receive an order for an item and, in response to receipt of the order for the item, a plurality of alternative fulfillment plans for moving the item from a sourcing point to each of the plurality of geographic locations within the supply chain are constructed. The instructions further evaluate each of the constructed plurality of alternative fulfillment plans against a predetermined criteria and select for implementation one of the

constructed plurality of alternative fulfillment plans that most closely meets the predetermined criteria. Predetermined criteria may include one or more of consolidation requirements, routing to delivery point, activity costs, transportation costs, holding costs, opportunity costs, excess inventory position, product age, margin on the order, customer classification, degree of cost flexibility, customer pricing tolerance, etc. The selected one of the plurality of alternative fulfillment plans is then used to position the very item that was the subject of the order at one of the plurality of geographic locations within the supply chain.

VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether a rejection under 35 U.S.C. § 103 can be maintained when the references being relied upon, whether considered alone or in combination, simply fail to disclose, teach, or suggest each and every element of the invention claimed.

VII. Argument

a) Status of the claims

In the application claims 11-20 remain pending. Claims 1-10 have been canceled. No claims presently stand allowed.

b) Summary of the rejection of the claims

Pending claims 11-20 stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Altendahl (U.S. Patent No. 6,571,213) as modified by Landvater (U.S. Patent No. 6,609,101).

In rejecting the claim, it was acknowledged that Altendahl fails to disclose, teach, or suggest the claimed “constructing a plurality of alternative fulfillment plans for moving an item from a sourcing point to each of a plurality of geographic locations within a supply chain.” Absent the disclosure of this claimed element, it must follow that Altendahl fails to disclose, teach, or suggest the further claim elements of “evaluating each of the constructed plurality of alternative fulfillment plans (i.e., constructed considering each of a plurality of geographic locations within a supply chain) against a predetermined criteria” and “selecting for implementation one of the constructed plurality of alternative fulfillment plans (i.e., constructed considering each of a plurality of geographic locations within a supply chain) that most closely meets the predetermined criteria...to position an item at one of the plurality of geographic locations within the supply chain.”

While Altendahl fails to disclose these claim elements, it was alleged that Landvater discloses “that it is well known that a business entity can have several establishments and factories which may require the delivery of the same systems/parts.”

The rejection of the claims then concluded that it would have been obvious to modify Altendahl to include those elements that have been acknowledged to be missing from Altendahl “because one of an ordinary skill in the art would know that any business entity can have more than one location distributed at different geographical locations” as disclosed by Landvater.

c) Applicable Law

It is well settled that a determination of obviousness requires that a combination of prior art references include each and every element set forth in the claims, considering each and every word (i.e., it is impermissible to distill a claimed invention down to its “gist” or “thrust.”). This

requirement that the claimed invention be considered “as a whole” is further meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the invention claimed. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection based upon a combination of references requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, confronted with the same problems and with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner. Furthermore, when performing this analysis, it is impermissible to pick and choose from a reference only so much as will support a given position while disregarding what the reference fairly teaches in its entirety. See, for example, *In Re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992).

d) Remarks Addressing The Cited References and The Rejection Of The Claims

Considering first Altendahl, within Altendahl a single, geographic destination for an item is required to be first established, i.e., the destination location is required to be predetermined. After the single, geographic destination is established, the system of Altendahl then merely functions to use various criteria to select a “route,” defined within Altendahl to be a parcel carrier (e.g., UPS) and parcel carrier service (e.g., ground or air), to position the item at that predetermined geographic destination, e.g., Chicago. (Col. 4, lines 17-32). It is therefore seen that Altendahl fails to disclose, teach, or suggest at least the claimed elements of constructing a plurality of alternative fulfillment plans for moving an item that is the subject of an order from a

sourcing point to each of plural geographic locations within the supply chain, evaluating each of the constructed plurality of alternative fulfillment plans against a predetermined criteria, and then selecting for implementation one of the constructed plurality of alternative fulfillment plans that most closely meets the predetermined criteria to thereby position the item that is the subject of the order at one of the plural geographic locations within the supply chain to thereby make the item available to meet the order.

When the claims are considered in their entirety it is further seen that, contrary to the position taken in the Advisory Action of September 13, 2005, Altendahl does not “anticipate all of the limitations of claim 11 except the teaching that the item is to be moved to a plurality of geographic locations instead of one location.” Rather, Altendahl fails to disclose a myriad of claim elements, i.e., not only the claim element acknowledged to be missing but all of the claim elements that subsequently rely upon the plurality of alternative fulfillment plans constructed considering each of plural geographic locations within a supply chain, and, more importantly, discloses a system which, at its very core, is fundamentally different that the invention set forth in the claims. In Altendahl the system requires the selection of a geographic location in which an item is to be positioned prior to the determination of a “route” (i.e., parcel carrier/service) whereas, in the invention claimed, the geographic location in which the item that is the subject of the order is to be positioned is not known until after the instructions evaluate *each of the constructed alternative fulfillment plans for each of plural destinations within a supply chain* against the predetermined criteria.

Considering now to Landvater, Landvater discloses a system that is used to forecast replenishment needs at select, predetermined locations, i.e., retail stores. More particularly, in Landvater a forecasting methodology is used to determine the amount of items to ship to each of

the predetermined locations as well as when to ship the items to each of the predetermined locations. In this manner, at a forecasted time and in a forecasted amount items may be positioned at the predetermined locations to meet anticipated needs for the items. (Col. 8, lines 26-47). Landvater, however, is simply silent as to any method for constructing or selecting a plan to move the forecast amount of items at the forecast time to each of the retail stores.

Having considered both Landvater and Altendahl, it is respectfully submitted that, since neither Landvater nor Altendahl disclose the claim elements of *constructing of a plurality of alternative fulfillment plans for moving an item that is the subject of an order from a sourcing point to each of plural geographic locations within the supply chain*, evaluating each of the constructed plurality of alternative fulfillment plans against a predetermined criteria, and then selecting for implementation one of the constructed plurality of alternative fulfillment plans that most closely meets the predetermined criteria to thereby position the item that is the subject of the order at one of the plural geographic locations within the supply chain to thereby make the item available to meet the order, it cannot be said that a combination of Altendahl and Landvater includes each and every element set forth in the claims as is required to maintain a rejection under 35 U.S.C. § 103. For this reason it is respectfully submitted that the rejection of the claims must be withdrawn.

It is additionally respectfully submitted that, since Landvater fails to disclose, teach, or suggest the very claim elements that are plainly missing from Altendahl, e.g., Landvater fails to suggest the desirability of *constructing a plurality of alternative fulfillment plans for each of plural geographic locations within a supply chain* which are thereafter evaluated against a predetermined criteria to thereafter select for implementation one of the constructed plurality of alternative fulfillment plans to position an item at one of the plural locations within the supply

chain, it is apparent that the suggestion for modifying Altendahl to arrive at the invention claimed could only have been arrived at using hindsight knowledge impermissibly derived from the disclosure of the subject application. More particularly, the motivation alleged for the modification of Altendahl, namely, “because one of an ordinary skill in the art would know that any business entity can have more than one locations distributed at different geographical locations,” cannot stand up to close scrutiny. In this regard, it has not been explained, and it is not evident, why a person of ordinary skill in the art would have found it obvious to reconstruct the system of Altendahl to include the claim elements missing from Altendahl – in the order claimed - merely because multiple retail stores may require similar items. Nevertheless, were one of skill in the art to follow the teachings of Landvater, considering Landvater in its entirety as is required, it is submitted that the teachings of Landvater would suggest modifying Altendahl such that a forecasting methodology would be first used to determine the amount of items to ship to each of plural predetermined locations, i.e., retail stores, as well as when to ship the items to each of the plural predetermined locations (“to thereby move multiple items to multiple stores” in keeping with the espoused motivation) with the items then being moved/shipped to each individual, predetermined location using the best Altendahl selected “route,” i.e., parcel carrier/service, for that individual, predetermined location. It will be appreciated that, in such a modified system, the selection of the Altendahl “route” will still be made considering only a single predetermined destination, i.e., a single retail store that the items are to be shipped to in the forecasted amount and at the forecasted time, and, as such, will still fail to include the claimed *constructing of a plurality of alternative fulfillment plans for each of a plurality of geographic locations within a supply chain* as well as the subsequent steps that rely upon the alternative fulfillment plans so constructed. It will be additionally appreciated that such a

modified system therefore remains in direct contrast to the methodology underlying the invention set forth in the claims, i.e., one in which the geographic location in which an item that is the subject of the order is to be positioned is not known until after the instructions evaluate each of the *constructed alternative fulfillment plans for each of a plurality of geographic locations within a supply chain* against a predetermined criteria.

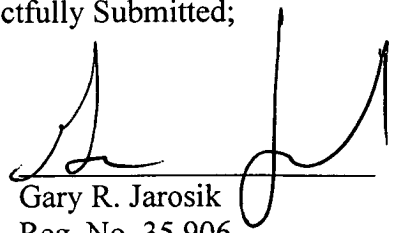
From the foregoing, it is respectfully submitted that the mere disclosure within Landvater of plural destination locations, i.e., retail stores, to which items are to be shipped cannot be said to evidence that that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have been motivated to modify Altendahl to arrive at the invention as is set forth in the claims. To conclude that this mere knowledge would suggest modifying Altendahl (as alleged in the rejection of the claims) to include the myriad of elements that are missing from Altendahl would be unduly speculative. Rather, it has been demonstrated that the express teachings of Landvater would suggest a modification of Altendahl that is no nearer to the claimed invention than is the system of Altendahl in its unmodified state. Therefore, for at least the reason that the application of Landvater cannot be said cure the shortcomings of Altendahl, it is respectfully submitted that a *prima facie* case of obviousness has not been presented and the rejection under 35 U.S.C. § 103 must be withdrawn.

In conclusion it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: October 21, 2005

By:

A handwritten signature in black ink, appearing to read 'Gary R. Jarosik', written over a horizontal line.

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VIII. Claims Appendix

The following is a clean copy of the claims involved in the appeal:

11. A computer readable media having instructions executable by a computer for use in selecting a fulfillment plan for moving an item within a supply chain distributed over a plurality of geographic locations, the instructions performing steps comprising:

receiving an order for an item;

in response to receipt of the order for the item constructing a plurality of alternative fulfillment plans for moving the item from a sourcing point to each of the plurality of geographic locations within the supply chain;

evaluating each of the constructed plurality of alternative fulfillment plans against a predetermined criteria; and

selecting for implementation one of the constructed plurality of alternative fulfillment plans that most closely meets the predetermined criteria, the selected one of the plurality of alternative fulfillment plan being used to position the item at one of the plurality of geographic locations within the supply chain thereby making the item available for use in meeting the order.

12. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using a customer specified level of service when constructing the plurality of alternative fulfillment plans.

13. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using branch and bound techniques to determine candidate sourcing points for the item when constructing the plurality of alternative fulfillment plans.

14. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using a customer specified point of delivery when constructing the plurality of alternative fulfillment plans.

15. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using a customer specified delivery date when constructing the plurality of alternative fulfillment plans

16. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using various combinations of sourcing points within the supply chain when constructing the plurality of alternative fulfillment plans.

17. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using customer specified consolidation requirements when constructing the plurality of alternative fulfillment plans.

18. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using activity costs when constructing the plurality of alternative fulfillment plans.

19. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using inventory age when constructing the plurality of alternative fulfillment plans.

20. The computer readable media as recited in claim 11, wherein the instructions further perform the step of using a customer specified price quote when evaluating the constructed plurality of alternative fulfillment plans against a predetermined criteria.

IX. Evidence Appendix

No evidence is being submitted herewith.

X. Related Proceedings Appendix

No copies of decisions rendered by a court or the Board are being submitted herewith.